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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,440	02/28/2006	Marc Husemann	101769-309-WCG	3424
27386 7590 05/25/2010 GERSTENZANG, WILLIAM C. NORRIS MCLAUGHLIN & MARCUS, PA 875 THIRD AVE, 8TH FLOOR NEW YORK, NY 10022				
EXAMINER				
DESAL, ANISH P				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,440

Applicant(s)

HUSEMANN ET AL.

Examiner

ANISH DESAI

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. Applicant's arguments in response to the Office action (OA) mailed on 11/27/09 have been fully considered.
2. In view of applicant's cancellation of previously presented claims, all of the claim objections, 112-first and second paragraph rejections, and the art rejections as set forth in the previous OA are moot.
3. Support for newly added claims is found in previously presented claims 1, 3, 5, 6, 8-13, and 15.
4. As to the 112-second paragraph rejection to claim term "shrinkback", the Examiner submits that in view of applicant's response, said rejection is withdrawn.
5. After reviewing applicant's response and the prior art of DE 196 12 367 as a whole, 102(b) rejection based on DE 196 12 367 (DE367) are no longer applicable to present claim 16 which is same in scope as to previous claim 1, because DE367 does not teach a primer layer as claimed; instead it teaches a release (anti-adhesive) layer (e.g. see second full paragraph on page 2).
6. In view of applicant's amendment, a new 112-second paragraph rejection is made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 17-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

8. Regarding claims 17-26, said claims depend from cancelled claims 1, 3, 5, and 12. As such claims are indefinite for being dependent from canceled claims. For the purpose of the examination, claims 17-23 depend from claim 16, claim 24 depends from claim 17, claim 25 depends from claim 24, and claim 26 depends from claim 18.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 16-19 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371).**

10. With respect to claims 16 and 18, Wallner teaches an antistatic PSA tape comprising a backing (carrier layer) coated with an antistatic primer layer (first electrically conductive primer layer), and a layer of PSA (first PSA) applied to the antistatic primer layer (column 1 lines 10-40). Moreover, Wallner is silent as to teaching the presence of electrically conductive particles in the PSA of the invention. Further, Wallner discloses polyacrylate adhesives at column 2 line 10.

11. With respect to claim 19 requirement of the PSA exhibiting a shrinkback, it is submitted that Wallner discloses same PSA as that of claimed by applicant, namely polyacrylate. Additionally, column 6 lines 14-15 of US 3,672,371 to Roeder is relied upon as an evidence to show that polyacrylates are elastomers. Based on this, since polyacrylates are elastomeric material, they would necessarily exhibit shrinkback. Shrinkback is interpreted as elastic property where a material will return to its original state (e.g. like a rubber band).

12. Wallner is silent as to teaching electrically conductive particles in the primer layer (claim 16), the primer layer comprises homogeneously distributed electrically conductive

particles (claim 17), and conductive particles as claimed in claim 23, and the amount of electrically conductive particles of claims 24-25.

13. However, Akhter discloses a static dissipative label (antistatic pressure-sensitive adhesive tape) comprising a backing film (carrier layer), at least one pressure-sensitive adhesive layer, and a primer layer containing electrically conductive particles that is between the carrier layer and the pressure-sensitive adhesive layer (abstract, column 1 lines 4-11, column 1 line 65 to column 2 lines 1-18, and Figure).

14. With regards to claim 17, the electrically conductive materials of Akhter are homogeneously dispersed throughout the binder resin matrix of the primer layer (column 2 lines 4-12). Additionally, regarding claim 23, the electrically conductive particles of Akhter are metal particles and polymer particles (column 3 lines 29-37). Further, with respect to claims 24-25, at column 3 lines 43-47 Akhter discloses that the primer layer comprises at least about 30% conductive particles.

15. It is noted that the primary reference of Wallner discloses an antistatic PSA tape having a primer layer that is antistatic (electrically conductive). Wallner is silent as to teaching electrically conductive **particles**. Akhter discloses antistatic label which comprises a primer layer having electrically conductive particles.

16. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the electrically conductive particles as required

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by claims 16, 17, and 23-25 as taught by Akhter in the primer layer of Wallner, because selecting a known material based on its suitability for its intended use establishes a *prima facie* case of obviousness (MPEP 2144.07).

17. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371) as applied to claim 16 above, and further in view of Kitamura et al. (US 5,759,679).

18. It is noted that while in claim 21 applicant intends to omit a second electrically conductive primer layer, however, it is submitted that the claim language does not explicitly exclude a second primer layer.

19. Regarding claims 20-21, Wallner is silent as to teaching the structure of the PSA tape as required by these claims.

20. However, Kitamura is relied upon to show that such a structure of the PSA tape is known in the art. For example, Kitamura discloses an adhesive tape with foamed substrate (carrier) (abstract). Further, Kitamura discloses that the PSA layer can be applied on one or both sides of the foamed substrate (carrier) (column 7 lines 14-20). Additionally, Kitamura discloses that in order to improve the anchoring property of the PSA layers, an undercoat treatment (primer layer) is applied to the surface(s) of the

carrier layer (column 7 lines 30-40). Additionally, Example 1-1 of Kitamura discloses application of undercoat to both sides of the carrier and application of PSA layers on both surfaces of the carrier layer.

21. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide PSA tape with the structure as presently claimed, motivated by the desire to form a suitable PSA tape.

22. **Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371) as applied to claim 16 above, and further in view of Luhmann et al. (US 6,395,389B1).**

23. Wallner is silent with respect to disclosing the PSA tape in the form of a punched product. However, such punched tapes are known in the adhesive art as disclosed by Luhmann.

24. The invention of Luhmann is directed to an adhesive tape strip (see abstract). According to Luhmann "Typical presentation forms [of the adhesive tape] include, **punched adhesive tape strip** sections covered on one side with a release laminate...forms." (column 4 lines 28-45).

25. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tape in the form of a punched product because selection of a PSA tape in a suitable form such as punched product as taught

by Luhamann would have been obvious, motivated by the desire to sell product of Wallner is the form of punched product.

26. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371) as applied to claims 16 and 23 above, and further in view of Craig et al. (US 6,299,799B1).

27. With respect to claims 24 and 25, while Akhter discloses electrically conductive particles including electrically conductive polymers (column 3 lines 30-36), Akhter does not disclose the weight% of said particles.

28. However, Craig discloses ceramer composition having antistatic properties (abstract). Further, the ceramer composition of Craig can be coated onto substrates which may be part of PSA tape (column 4 lines 1-10). At column 4 lines 38-45, Craig discloses ceramer composition of his invention comprises electrically conductive polymer in the amount of 0.05 to 50 weight%.

29. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the electrically conductive particles including electrically conductive polymers of Akhter in the amount as taught by Craig, motivated by the desire to provide suitable antistatic property to the primer layer.

30. **Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371) as applied to claims 18 above, and further in view of De Jonge et al. (US 6,284,837B1).**

31. The invention of Wallner is previously disclosed. Wallner is silent with respect to teaching polymethacrylate PSA.

32. However, De Jonge discloses PSA tapes and labels comprising polymethacrylate adhesives (see abstract and column 3 lines 35-40). Further, the PSA of De Jonge has excellent adhesive nature and good adhesion to substrates of varied nature (column 2 lines 40-45).

33. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the adhesive of De Jonge which reads on the presently claimed invention's adhesive in the invention of Wallner, motivated by the desire to use the PSA that has excellent adhesive nature and good adhesion to substrates of varied nature (column 2 lines 40-45).

Response to Arguments

34. Applicant's arguments filed on 03/02/10 have been fully considered but they are not persuasive.

35. On page 9 of the amendment (see third full paragraph), applicant argues that Wallner does not teach or suggest anything about a primer layer that contains conductive particles.

36. The Examiner respectfully submits that Wallner is not relied upon to teach or suggest conductive particles in the primer layer; instead Akhter is relied upon to teach this limitation. Accordingly, the Examiner respectfully reminds applicant that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

37. Further, on pages 9-10 of the amendment, applicant argues that one would not combine the conductive particles of Akhter in the primer of Wallner given that Akhter relies on incorporation of conductive particles in the primer and the PSA. Further, applicant argues that Wallner's antistatic polymers operate by a completely different principle than that of Akhter's particles. Additionally, applicant argues that Wallner clearly states that he does not understand why his inogenic polymer containing primer works to dissipate electrical charge (column 1 lines 62-68).

38. The Examiner respectfully disagrees. It is submitted that whether Wallner understands or not how his inogenic polymer containing primer works is not a relevant to the *prima facie* case of obviousness as set forth in the OA. Rather, the question is

whether one of ordinary skill in the art would have found it obvious to select electrically conductive particles of Akhter and used them in the primer of Wallner. Further, it is submitted that the function of Wallner's antistatic polymers and Akhter's electrical particles is same, namely to dissipate electrical charge (column 1 lines 25-40 and column 2 lines 55-60 of Wallner, column 1 lines 5-10 and column 3 lines 5-10 of Akhter). Further, Wallner already makes clear to one of ordinary skill in the art that incorporation of antistatic agent in the adhesive will result in inferior adhesive (see column 1 lines 55-59). As such since Wallner is the primary reference being modified, one of ordinary skill in the art who is in possession of Wallner recognizes that Wallner does not desire addition of antistatic agents (i.e. inorganic polymer of Wallner or conductive particles) in the adhesive. Based on this, the Examiner respectfully submits that while Akhter may teach of adding conductive particles (antistatic agent) in both the primer layer and the PSA layer, one of ordinary skill in the art recognizes not to add conductive particles of Akhter in the PSA of Wallner.

39. Further, with respect to applicant's assertion that one would not combine Wallner with Akhter given that the electrical conductivity of Wallner operates by different principle than the particle of Akhter, the Examiner also submits following:

40. It is submitted that it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose...[T]he idea of combining them flows

logically from their having been individually taught in the prior art (see MPEP 2144.06). As such, applicant's arguments are not found persuasive.

41. On page 11 of the amendment (see third full paragraph), applicant disagrees with the Examiner's rejection of claim limitation of "shrinkback" (new claim 19). Applicant argues that "The Examiner however has derived his own definition of shrinkback, and the meaning he assigns to that term is different than that understood by those skilled in the art, as explained above."

42. The Examiner respectfully disagrees. While, it is noted that applicant has referred to specification and US Patent 7,022,408 for the meaning of the term "shrinkback", the Examiner submits that while the specification and the aforementioned US Patent describes how one measures shrinkback, this does not serve as a "definition" of the term "shrinkback". Further, the Examiner submits that it is well understood that during the prosecution of a patent application, claims are given their broadest reasonable interpretation in light of the supporting disclosure. Further, while claims are interpreted in light of the specification, but limitations from the specification are not imported into the claims (see MPEP 2106 C). Since, applicant's specification does not "define" what is meant by "shrinkback", said term is interpreted as elastic property where a material will return to its original state after being stretched (e.g. like a rubber band). It is submitted that Wallner discloses same PSA as that of claimed by

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applicant, namely polyacrylate. Additionally, column 6 lines 14-15 of US 3,672,371 to Roeder is relied upon as an evidence to show that polyacrylates are elastomers. Based on this, absent factual evidence on the record, since polyacrylates are elastomeric material, they would **necessarily** exhibit shrinkback. Further, as to applicant's arguments that the shrinkback is a measure of orientation, it is submitted that said arguments are not commensurate in scope with the presently claimed invention. Presently claimed invention does not require that the PSA is oriented and/or that shrinkback is attributed due to the orientation of PSA. Accordingly, applicant's arguments are not found persuasive.

43. On page 13 of the amendment (first full paragraph), with respect to claim 22, applicant argues that a punched tape cannot in any way overcome the failure of Wallner/Akhter/Roeder combination.

44. In response, the Examiner submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

45. As to claims 20, 21, 24, and 25 (see pages 12 and 14), it is noted that applicant has essentially incorporated the comments as set forth above with respect to Wallner

and Akhter references. In response, the Examiner has nothing more to add but to incorporate his rebuttal as set forth above here by reference.

Conclusion

46. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

47. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

48. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 9:00AM-5:30PM.

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49. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

50. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1794

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1787